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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/850,113	05/08/2001	Christian Oldendorf	Q64288	4642

7590 10/23/2003

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EXAMINER	
GIBSON, RANDY W	

ART UNIT	PAPER NUMBER
2841	

DATE MAILED: 10/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/850,113	OLDENDORF ET AL.	
	Examiner	Art Unit	
	Randy W. Gibson	2841	

-- The MAILING DATE of this communication appears on the cover she t with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *1-9, 12, and 13* is/are allowed.

6)☒ Claim(s) *10,11,14 and 15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

1. Claims 10 and 11, which were originally indicated as allowable, upon further review by the office of the Special Programs Examiner, have been rejected. Accordingly, prosecution of this application has been re-opened. The delay of making this rejection is regretted.

Rejections under 35 USC § 251

2. Claims 10, 11, 14 and 15 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc.* v. *Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement,* 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp.* v. *United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Applicants have broadened/omitted certain claim requirement surrendered during prosecution of the patent in reissue (US 5,902,965). A review of the prosecution of application No. 09/019.712, which matured into US patent No. 5,902,965, reveals that,

in response to the PTO's rejection of all the claims on November 2, 1998, applicant cancelled claims 1 and 2 without prejudice or disclaimer. Claims 1 and 2 were directed to a method of weighing out quantities of ingredients into a container where the second ingredient is added to the container containing the first ingredient. The two ingredients would inherently mix (particularly, if the ingredients are liquids, column 1, lines 16-24).

Claims 10 and 11 of this reissue are drawn to a method of mixing components using an electronic balance. Although the preamble of claims 1 and 2 differ from the preamble of claims 10 and 11, the preamble does not add patentable weight to the steps of mixing liquids and thus claims 10 and 11 are essentially the same as in cancelled claims 1 and 2 of S/N# 09/019,712. The preamble merely recites the purpose of the process and the body of the claim does not depend on the preamble for completeness. The process steps are able to stand alone. Additionally, claims 10 and 11 are broadened with respect to claims 1 and 2 because they omit the last step required by claims 1 and 2. This broadening of subject matter surrendered during prosecution of the original patent is barred by recapture.

Claims 10 and 11 of this reissue are drawn to a method of mixing components using an electronic balance. Although the preamble of claims 1 and 2 differ from the preamble of claims 10 and 11, the preamble does not add patentable weight to the steps of mixing liquids and thus claims 10 and 11 are essentially the same as in cancelled claims 1 and 2 of SN# 09/019,712. The preamble merely recites the purpose of the process and the body of the claim does not depend on the preamble for completeness. The process steps are able to stand alone.

Additionally, claims 10 and 11 are broadened with respect to claims 1 and 2 because they omit the last step required by claims 1 and 2. This broadening of subject matter surrendered during prosecution of the original patent is barred by recapture.

3. Claims 10, 11, 14 and 15 are rejected under 35 U.S.C. 251 as being broadened in a reissue application filed outside the two year statutory period. The instant reissue application, filed May 8, 2001, is a reissue of US Patent 5,902,965, which claims priority under 35 U.S.C. 120 to US Patent 5,847,328. US Patent 5,847,328 issued on December 8, 1998 almost two and a half years before the filing of this reissue. Claims 10 and 11 in the instant reissue are each broader than claims 1 and 2 of US Patent 5,847,328 in respect that claims 10 and 11 do not require the final step of adding the additional amount of the first ingredient. A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.

While it is acknowledged that claiming subject matter that was not claimed in the original patent is not improper in and of itself, *In re Amos,* 21 USPQ2d 1271, claims 10 and 11 in this reissue are an attempt to broaden claims of US Patent 5,847,328. This broadening is impermissible because it effectively undermines the purpose of the statute, 35 USC 251 fourth paragraph, which is to put the public on notice of any intent to broaden within two years after issuance of the patent.

4. Claims 10, 11, 14 and 15 are rejected under 35 USC 251, first paragraph, as not being directed to an error, which deems the patent to be wholly or partially inoperative and invalid. The error of claim 1 referred to in the oath applies to an electronic balance which is distinct from the processes of claims 10 and 11. Further, claims 10 and 11 still require a an electronic means and calculates an amount for the first ingredient. Failure of the attorney to appreciate the full scope of the invention was held to be an error correctable by reissue, *In re Wilder* 22 USPQ 369. While failure to recognize the full scope of the original patent is an error correctable by reissue, the failure to recognize the full scope of a patent other than the original patent on which the reissue is based is not an error that is correctable by reissue. An error resulting from lack of appreciation of the full scope of the parent 5,847,328 patent cannot be corrected by reissue of the child patent 5,902,965. Correction of this kind of error in reissue circumvents the statutory requirement of 35 USC 251 forth paragraph that the public must be notified of an intent to broaden claims in an issued patent within two years from issuance.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 10 and 11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 5,847,328. Although the conflicting claims are not identical, they are not patentably distinct from each other because the activation step does not provide patentable distinction from the electronic device of the patent. The electronic device will perform the functions claimed.

Conclusion

6. Claims 1-9, 12, and 13 are still allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randy W. Gibson whose telephone number is (703) 308-1765. The examiner can normally be reached on Mon-Fri., 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David S Martin can be reached on (703) 308-3121. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-5115.

Randy W. Gibson

RANDY GIBSON
PRIMARY EXAMINER